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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

005288.00005

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on _____

Signature _____

Typed or printed name _____

Application Number

09/834,264

Filed

April 12, 2001

First Named Inventor

Yairi

Art Unit

2154

Examiner

A. Patel

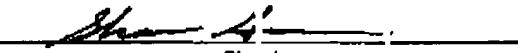
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor.

Signature

 assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Shawn P. Gorman

Typed or printed name

 attorney or agent of record.

Registration number 56,197

312.463.5000

Telephone number

 attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

March 6, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this time should be sent to the Chief Information Officer.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of Yairi)	Confirmation No. 2757
Application No. 09/834,264)	Group Art Unit: 2154
Filed: April 12, 2001)	Examiner: A. Patel
For: Method for Managing Multiple)	
Dynamic E-Mail Aliases)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW**Box AF**

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-14501

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the final Office Action dated November 28, 2005, Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The specific errors relied upon in this Pre-Appeal Brief Request for Review include the following:

- The pending 35 U.S.C. §102 rejection fails to address all the claim limitations, and
- The pending 35 U.S.C. §102 exhibits clear factual error with respect to interpretation of U.S. Pat. No. 6,438,583 to McDowell *et. al.*, hereinafter "McDowell".

Application No.: 09/834,264
Pre-Appeal Brief Request for Review

Claims 1-13 stand twice rejected. In the most recent Office Action dated December 19, 2005, claims 1- 13 are rejected under 35 USC §102(e) as allegedly being anticipated by U.S. Pat. No. 6,438,583 to *McDowell et. al.*, ("McDowell"). Applicants submit there is clear legal and factual deficiencies in the rejection.

"The present invention provides an e-mail system that allows users to efficiently manage several different e-mail accounts. ...E-mail messages addressed to the related e-mail accounts can be delivered to a single in-box and the user may be allowed to add and delete e-mail addresses." (Specification, page 2, lines 18 – Page 3, line 3). Specifically, exemplary claim 1 recites:

A method of routing electronic mail messages to a user with a server, the method comprising the steps of:

- (1) receiving at a mail server an electronic mail message having a destination address;
- (2) receiving from a user at the mail server an identification of a main electronic mail address and at least one alias electronic mail address;
- (3) comparing the destination address to the main and at least one alias electronic mail addresses; and
- (4) transmitting the electronic mail message to an address determined

identification of a main electronic mail address and at least one alias electronic address is found in Col. 7, lines 50 – 62 of McDowell. The text referenced in underlined bold font in the Office Action states "an alias table is created in the old ISP wherein the recipient's former Internet address is mapped to a new address in the table". (Office Action dated December 19, 2005; page 3; emphasis added). As recited in McDowell, the alias table created by the old ISP merely maps a former e-mail address to a new address. Indeed, the specification of McDowell makes it clear that "the present invention comprises a method an apparatus for rerouting e-mail destined for a person or entity formerly located at a given ISP and forwarding that e-mail to the new email address for the recipient. (Col. 6, lines 48 – 51; emphasis added). Indeed, every description of rerouting an email is disclosed in the context of forwarding the single e-mail to a new address. (*see e.g.*, Abstract, Col. 2, lines 1 – 5; Col. 3, lines 60 – 63; Col. 7, lines 47 – 49).

Application No.: 09/834,264
Pre-Appeal Brief Request for Review

In describing the functioning of the alias table, McDowell provides that “[t]he re-route server looks through its alias table for the recipient, and determines the recipient's new address. The mail is then forwarded via the Internet 42, to the new ISP 38, where it is stored until downloaded by the recipient's computer 40.” (Col. 8, lines 9 – 13; emphasis added). This shortcoming is similar to that of the '508 patent (“Agraharam”), which was previously cited against the claims. Indeed, in the Amendment and Request for Reconsideration dated November 22, 2005, the Applicants distinguished Agraharam from the rejected claims by stating:

[T]he Applicant respectfully submits that Agraharam does not disclose “receiving at a mail server” and “comparing the destination address to the main and at least one alias electronic mail addresses.” The translation server in Agraharam is fundamentally different from the claimed “mail server.” And, at most the translation server in Agraharam compares a destination address to one other value, the alias address, and does not perform the operation of ‘comparing the destination address to the main and at least one alias electronic mail addresses.’”

(Amendment and Request for Reconsideration dated November 22, 2005; page 7). The rejection citing Agraharam was dropped and replaced with McDowell. McDowell, like Agraharam, merely shows one email address (former address) being mapped to another address (the new address), therefore, there can be no teaching of the limitations:

- (3) comparing the destination address to the main and at least one alias electronic mail addresses; and
- (4) transmitting the electronic mail message to an address determined as a result of the comparing step

(Claim 1, emphasis added; see also, Claim 3, 10, 12 and 13). In McDowell, the mail message is being transferred from the former mail address to an alias mail address determined by an alias table at the old ISP. Therefore, the former address is not considered or otherwise “compared” when determining where to transmit the mail message nor is the identification of a main electronic mail address and at least one alias electronic mail address received by a user.

In fact, nowhere does McDowell show the comparison of two or more valid email addresses that are compared to determine where the email is transmitted as recited in the rejected claims. Therefore, in view of the foregoing, the Applicants respectfully request reversal of the rejection with respect to Claims 1 – 13.

While Applicants believe the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. In addition, Applicants believe the

Application No.: 09/834,264
Pre-Appeal Brief Request for Review

rejections of other claims not identified above are also based on one or more Office errors. Applicants will address such issues on appeal should the appeal of this case proceed after the Office's consideration of this paper.

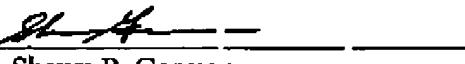
CONCLUSION

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (312) 463-5434.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 6th day of March, 2006

By: 

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